

**REMARKS**

Reconsideration of the present application is respectfully requested. Claims 38 to 42, 44 to 49 and 51 to 57 are currently pending, and no claims have been amended.

The Office Action mailed November 5, 2003 addressed claims 38 to 42, 44 to 49 and 51 to 57. Claims 38 to 42, 44 to 49 and 51 to 57 were rejected.

Claims 38 to 42, 44 to 49 and 51 to 57 were rejected under 35 U.S.C. § 102(e) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Yamagishi et al. (5,779,563). Regarding claim 38, the Examiner stated that Yamagishi discloses a golf ball comprising a solid core, an inner cover layer and an outer cover layer, the inner cover layer is made from Himilan (an ionomer), and the outer cover is made from polyurethane and has a Shore D hardness from 40 to 68. The Examiner stated that with respect to the core PGA compression, Applicant discloses the conversion of deformation to PGA compression, and using the conversion Yamagishi discloses a core PGA compression of 3 to 121 (core deflection of 2 to 5 mm). Regarding claim 40, the Examiner stated that the ball has a diameter of 42.7 mm or 1.68 inches; regarding claim 42, the outer cover layer has a Shore D hardness of 40 to 68; regarding claims 44 and 45, the outer cover layer has a thickness of 0.3 to 2.5 mm or 0.01 to 0.098 inches; and regarding claim 47, the solid core is made from a polybutadiene, the outer cover layer is made from polyurethane and has a Shore D hardness of 40 to 68. Regarding core PGA compressions, the Examiner stated that Applicant discloses the conversion of deformation to PGA compression, and using the conversion Yamagishi discloses a core PGA compression of 3 to 121 (core deflection of 2 to 5 mm). Regarding claims 51 and 52, the Examiner stated that the outer cover layer has a thickness of 0.3 to 2.5 mm or 0.01 to 0.098 inches; and regarding claim 53, the solid core is made from a polybutadiene, the inner cover layer is made from Himilan, and the outer cover is made from polyurethane and has a Shore D hardness from 40 to 68. Regarding core PGA compressions, the Examiner stated that Applicant discloses the conversion of deformation to PGA compression, and using the conversion Yamagishi discloses a core PGA compression of 3 to 121 (core deflection of 2 to 5 mm). Regarding claim 55, the Examiner stated that the ball has a diameter of 42.7 mm or 1.68 inches. Regarding claims 39, 41, 48, 54 and 56, the Examiner stated that Applicant claims a PGA compression and coefficient of restitution, and the properties will be similar to the properties of Yamagishi because Yamagishi discloses a solid golf ball

comprising a polybutadiene core, an ionomeric cover and a polyurethane outer cover, and Applicant claims the same materials disclosed by Yamagishi for each layer. The Examiner further stated that although Yamagishi is silent, one skilled in the golf ball art is aware that golf balls commonly have a PGA compression between 70 and 100, and the COR has a common range in the golfing art between 0.7 and 0.8. Regarding claims 46, 49 and 57, the Examiner stated that Yamagishi in view of Sullivan discloses Applicant's invention therefore the performance features such as mechanical impedance will also be the same as Applicant's. The Examiner concluded that one of ordinary skill in the art would have modified Yamagishi to achieve the optimal initial velocity and spin of the golf ball.

Applicants respectfully disagree with the Examiner and submit that Yamagishi neither anticipates nor renders obvious Applicants' invention. Claims 38, 47 and 53 claim a golf ball with a core having a PGA compression of 55 or less and the golf ball has a PGA compression of 80 or less. Applicants respectfully submit that Yamagishi et al. does not disclose a golf ball with a core having a PGA compression of 55 or less or where the golf ball has a PGA compression of 80 or less, nor does Yamagishi et al. provide any suggestion or teaching to make a golf ball with the PGA compression of Applicants' golf balls. Applicants respectfully submit that core deflection measured in Yamagishi is measured using a different load than the PGA compression, therefore it cannot be converted in the manner suggested by the Examiner. Even if the conversion were correct, Yamagishi does not disclose a core having a PGA compression of 55 or less, but instead, the compression, as calculated by the Examiner, would be 3 to 121, which is a very different range than that claimed by Applicant. Yamagishi also discloses a golf ball wherein the outer cover layer has a higher specific gravity than the core and inner cover layer, and the ball has an inertia moment within a certain range.

Applicants respectfully submit that one skilled in the art would not be motivated to modify the golf ball of Yamagishi in the manner suggested by the Examiner. Applicants respectfully submit that the burden is on the Examiner to provide a basis in fact and/or technical reason to reasonably support the determination that the allegedly inherent or obvious characteristics necessarily flow from the teachings of the prior art. Inherency must be a necessary result and not merely a possible result. Applicants respectfully submit that the Examiner has failed to support the inherency determination with any facts or technical reasoning. Even if it is true that golf balls

commonly have a PGA compression between 70 and 100, as stated by the Examiner, this is different from a golf ball having a PGA compression of 80 or less. Additionally, the Examiner stated that "the properties will be similar to" the properties of Yamagishi, not necessarily the same as those of Yamagishi and vice versa.

For at least these reasons, Applicants respectfully submit that claims 38 to 42, 44 to 49 and 51 to 57 are not obvious under 35 U.S.C. § 103(a) over Yamagishi et al. in view of Sullivan et al. Applicants therefore respectfully request that the rejection of claims 38 to 42, 44 to 49 and 51 to 57 be reconsidered and withdrawn.

The Examiner is invited to telephone Applicants' attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

**CONCLUSION**

Applicants respectfully request reconsideration and allowance of each of the presently rejected claims, claims 38 to 42, 44 to 49 and 51 to 57. Applicants respectfully request allowance of claims 38 to 42, 44 to 49 and 51 to 57, the claims currently pending.

Respectfully submitted,

MICHAEL J. SULLIVAN ET AL.

Date: February 5, 2004  
Customer No. 24492  
Phone: (413) 322-2937

By Michelle Bugbee  
Michelle Bugbee, Reg. No. 42,370  
Attorney for Applicants  
The Top-Flite Golf Company  
A wholly-owned subsidiary of Callaway Golf Company  
425 Meadow Street  
P.O. Box 901  
Chicopee, MA 01021-0901